UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,251	12/12/2001	Ernst-Michael Hamann	DE920000050US1	1718

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EXAMINER
WALSH, DANIEL I

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No.	Applicant(s)
	10/015,251	HAMANN ET AL.
	Examiner	Art Unit
	Daniel I Walsh	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) _12-14_ is/are allowed.

6)☒ Claim(s) _1,9-11 and 15_ is/are rejected.

7)☒ Claim(s) _2-8_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

1.   Receipt is acknowledged of the Priority Papers received on 12 December 2001.

Claim Objections

2.   Claims 9 and 12 are objected to because of the following informalities:

Re claim 9, line 1: Replace "System" with -- Method --.

Re claim 9, line 2: Replace "1 to 8" with -- to 1 --.

Re claim 12, line 18: Replace "the data" with – data --.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under

35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3.   Claims 1, 9-11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Graham, Jr. et al. (US 6,402,028) in view of Tushie et al. (US 6,202,155)

Graham, Jr. et al. teaches a method for the personalization of smart cads through an

integrated production of smart cards. Though Graham, Jr. et al. does not specifically teach the

production of a virtual card, Graham, Jr. et al. teaches the creation of a script which combines all

of the production aspects of a card into a script, that includes resources available on the card,

memory, applications, physical attributes, documents the software infrastructure, security, and

compatibility, etc. and is created/defined before actual production of the card (abstract), and is

therefore interpreted as a virtual smart card, as it represents a virtual creation of the actual card,

and defines its resources, profiles, etc.. It is understood that the production process includes a

card reader, as a physical card is produced (FIG. 3) with the data objects (profiles, settings,

applications, etc.) as defined by the script, being places into memory of the card. Further, it is

understood that the logical file structure (804) created by the script via step 516 is the same as

the logical file structure of the real smart card, as the combined file structure for the applications

can includes an overall file hierarchy starting at the ISO 7816-6 master file as a root directory

and describes directories and files (col 14, lines 30+). It is understood that the script defines

areas for data objects (applications, identity information, etc) to be placed (in memory), as per

the profiles described above, and that such a card would be produced by the script in

communication with the card reader/writer. Though Graham, Jr. et al. is silent to a virtual smart

card and a personalization program, the script building of Graham, Jr. et al. is functionally

equivalent as it teaches personalization (FIG. 5) and defines a card virtually before a physical

card is produced. Therefore, specifying a virtual card and personalization program is

functionally equivalent design variation that does not solve a particular problem or teach a

limitation that is not met by the prior art, and therefore is not seen as novel, nor patentably

distinct in function.

Tushie et al. teaches the production of a virtual smart card, whereby information is

received by a virtual card personalization system to make the virtual card. Virtual devices in the

system control the physical equipment, which is used to produce the "real" personalized card

(abstract), and can incorporate the use of scripts (FIG. 5A-5E). Via FIG. 1 it is obvious that the

personalization program/system communicates with a physical reader/writer to produce the card,

by electronically transferring the data objects (object oriented programming objects) from the

smart card into the areas of the real smart card (col 5, lines 35+) and that the file structure of the

virtual and real cards are identical, and include image object, IC object, etc. (col 6, lines 7+), as

defined by the virtual card object which is used to produce the card.

Re claim 9, via Tushie et al. it is understood that the personalization equipment 130

personalizes the smart cards installed on the data processing system at the personal side. It is

obvious its has an interface to a file containing data relating to a certain virtual smart card

including an interface to read the data objects in the smart card and an interface to smart card

specific commands, since the virtual card personalization system interfaces with the physical

equipment (including reader/writer) to transmit the data objects and necessary commands from

the virtual card and system to the "real" personalization system, whereby a physical card is

produced in the image of the virtual card.

Re claim 10, via Tushie et al., it is understood that a reader is included in the

personalization equipment 130 to produce smart card 160, as is conventional in the art. Though

Tushie et al. fails to teach separate programs/agents for reading and writing, and instead teaches an integrated approach, at the time the invention was made, it would have been an obvious matter of design variation to separate an integrated means into separate/distinct, yet functionally equivalent means, and is well within the skill in the art.

Re claim 11, via Tushie et al. it is obvious that an integral program is installed at the personalization side, in the form of the virtual card personalization system, that includes the limitations of the control and card agent programs.

Re claim 15, it is obvious that the scripting language can be seen as a computer program product stored on a computer/system for causing a comptuer to perform the method of claim 1 (i.e. personalization/customization).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Graham, Jr. et al. with those of Tushie et al.

One would have been motivated to do this in order to have a virtual system whereby virtual devices control physical personalization devices/processes that is flexible and does not require as much reconfiguring as conventional systems.

Allowable Subject Matter

3.   Claims 2-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4.   Claims 12-14 are allowed.

5.   The following is an examiner's statement of reasons for allowance: Though the prior art

of Graham, Jr. et al. teaches the creating of a defined logical file structure, a database storing

personalization information, collecting personal information in a database, and a reader to

communicate with the real card the prior art fails to teach automatically assigning a password

and unique identifier to each defined file structure, where the file structure is defined as having a

public area, private area, a secret key area and a password area, generating and replacing an

individual password and replacing the real smart cards password with the new password, creating

the virtual card and identifier using a virtual smart control program, that the password is used to

load memory of the virtual smart card, that the personalization program accesses the virtual

smart card and assigned unique identifier and password and that data objects of the virtual smart

card are transferred by means of the password and card specific commands to the real smart card,

as the prior art is silent to passwords being associated with the transfer of data from the virtual

card to the real card.

        Any comments considered necessary by applicant must be submitted no later than the

payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for

Allowance."

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure: Goman et al. (US 6,196,459), Lee et al. (US 6,367,011), Hagn (US 6,575,360),

Tushie et al. (US 6,014,748), Hamann et al. (US 6,516,357), Peyret et al. (US 5,923,884), and
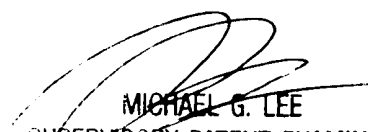
Benson (EP 000936530A1).

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Daniel Walsh whose telephone number is (703) 305-1001. The

examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through

Friday.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for this

Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

        Communications via Internet e-mail regarding this application, other than those under 35

US.C. 132 or which otherwise require a signature, may be used by the applicant and should be

addressed to **[daniel.walsh@uspto.gov]**.

> All Internet e-mail communications will be made of record in the application file. PTO
> employees do not engage in Internet communications where there exists a possibility that
> sensitive information could be identified or exchanged unless the record includes a properly
> signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more
> clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the
> Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the Group receptionist whose telephone number is (703) 308-0956.

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

DIW
6/11/03